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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,544	09/23/2007	Yukimitsu Suda	TOS-172-USA-PCT	4499
27955	7590	08/17/2011	EXAMINER	
TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1762	
			MAIL DATE	DELIVERY MODE
			08/17/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,544

Applicant(s)

SUDA ET AL.

Examiner

MARIE REDDICK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-5 and 8 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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DETAILED ACTION

1. The indicated allowability of claims 1-5 and 8 in the “Ex Parte Quayle” Office Action (03/21/11) is withdrawn in view of the newly discovered 112, 2nd paragraph issues. An apology is extended to applicants for any inconvenience that this may have caused. A telephone call was made to Mr. Donald Townsend, Jr. on August 11, 2011 in an attempt to remedy the issues raised infra and place the application in condition for allowance. However, Counsel was not available.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A METHOD OF MANUFACTURING PROTEIN ADSORPTION EYE LENS MATERIAL.

Claim Objections

3. Claims 1, 5 and 8 are objected to because of the following informalities: In claim 1, line 7, it is suggested that “phosphorylcholine group-containing” be used in lieu of “phosphorylcholine-group containing”. In claim 5, line 7 and claim 8, lines 4-5, it is suggested that a “hyphen” be inserted between “group” and “containing”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "A method of manufacturing an eye lens material preventing protein adsorption comprising: reacting in a reaction medium selected from the group consisting of water, an organic solvent, and a water/organic solvent mixture an eye lens material having OH groups with a phosphorylcholine group-containing compound of formula (1) below, thereby forming an acetal bond according to the compound of formula (2) below, to covalently bond the phosphorylcholine-group containing compound to the eye lens material:" per claim 1 constitutes indefinite subject matter as per said phrase engendering awkwardly expressed and confusing claim language and furthermore, it is not readily ascertainable as to the nexus between the compound of formula (1) and the compound of formula (2). The following language is suggested: "A method of manufacturing an eye lens material that prevents protein absorption, said method comprising: reacting in a reaction medium selected from the group consisting of water, an organic solvent, and a water/organic solvent mixture an eye lens material having OH groups on the surface with a phosphorylcholine group-containing compound of formula (1) below, thereby forming a compound having an acetal bond according to formula (2) below, to covalently bond the phosphorylcholine group-containing compound to the eye lens material:"

B) The recited "A method of manufacturing an eye lens material preventing protein adsorption in which OH groups are first introduced onto the surface of the eye lens material by means of plasma pretreatment, comprising reacting in a reaction medium selected from the group consisting of water, an organic solvent, and water/organic solvent mixture a plasma

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pretreated eye lens material with a phosphorylcholine group-containing compound of formula (1) below, thereby forming an acetal bond according to formula (2) below, to covalently bond the phosphorylcholine group containing compound to the eye lens material:" per claim 5 constitutes indefinite subject matter as per said phrase engendering awkwardly expressed and confusing claim language and furthermore, it is not readily ascertainable as to the nexus between the compound of formula (1) and the compound of formula (2). The following language is suggested: "A method of manufacturing an eye lens material which prevents protein adsorption wherein OH groups are first introduced onto the surface of the eye lens material by means of a plasma pretreatment, said method comprising reacting in a reaction medium selected from the group consisting of water, an organic solvent, and a water/organic solvent mixture, a plasma pretreated eye lens material having OH groups on the surface of the eye lens material with a phosphorylcholine group-containing compound of formula (1) below, thereby forming a compound having an acetal bond according to formula (2) below, to covalently bond the phosphorylcholine group-containing compound to the eye lens material:"

C) The recited "A method for preventing protein adsorption on an eye lens material containing OH groups is prevented by means of an after-treatment, comprising: reacting in a reaction medium selected from the group consisting of water, an organic solvent, and a water/organic solvent mixture said eye lens material with a phosphorylcholine group containing compound of formula (1) below, thereby forming an acetal bond according to formula (2) below, and a covalent bond with the eye lens material:" per claim 8 constitutes indefinite subject matter as per said phrase engendering awkwardly expressed and confusing claim language and furthermore, it is not readily ascertainable as to the nexus between the

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compound of formula (1) and the compound of formula (2). The following language is suggested: "A method for preventing protein adsorption on an eye lens material containing OH groups by means of an after-treatment, said method comprising: reacting in a reaction medium selected from the group consisting of water, an organic solvent, and a water/organic solvent mixture said eye lens material having OH groups on the surface with a phosphorylcholine group-containing compound of formula (1) below, thereby forming a compound having an acetal bond according to formula (2) below, to covalently bond the phosphorylcholine group-containing compound to the eye lens material:"

Allowable Subject Matter

6. Claims 1-5 and 8 are deemed allowable over the prior art of record.

7. The following is a statement of reasons for the indication of allowable subject matter: The instantly claimed invention is deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the precisely defined method of manufacturing an eye lens material (claims 1-5) and a method of preventing protein adsorption on an eye lens material containing OH groups (claim 8). One having ordinary skill in the art would not have been endowed with any reasonable motivation to extrapolate, from any of the prior art of record, the precisely defined method of manufacturing an eye lens material (claims 1-5) and a method of preventing protein adsorption (claim 8) with any reasonable expectation of success. Specifically, none of the prior art of record teaches treating a surface of a contact lens having OH groups with a phosphorylcholine group-containing compound of formula (1) thereby forming an acetal bond according to the compound of formula (2) so as to covalently bond the phosphorylcholine group-containing compound to the eye lens material, as claimed.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIE REDDICK whose telephone number is (571)272-5816.

The examiner can normally be reached on Mon. - Fri. 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WU DAVID can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marie Reddick
Patent Examiner
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/MR/
08/12/11

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